

REMARKS/ARGUMENTS

The claims have been amended as set forth above. Claims 1-44 are cancelled. Independent claim 45 is amended. Claims 46-47 are previously presented and claims 48-53 are new. Reconsideration is respectfully requested.

I. Examiner Interview Dated March 5, 2008

An interview was held on March 5, 2008. During the interview, the specification of the application and the cited references were discussed. An agreement as to allowability was not reached. Applicants believe that the current changes overcome the cited references.

II. Rejection Under 35 U.S.C. 112, First Paragraph

Claims 1 and 20 are rejected under 35 U.S.C. 112, first paragraph. The Office Action asserts that the phrase "in response to engaging" is not described in the specification filed at the time of invention. Applicant respectfully disagrees. (See specification at page 2, lines 16-18; see also specification at page 7, lines 17-19; see also specification at page 9, lines 9-21; see also specification at page 10, lines 9-11; see also specification at page 10, line 29- page 11, line 4). In light of the above portions of the specification, reconsideration is respectfully requested.

III. Rejections Under 35 U.S.C. 103(a)

Claims 1-10, and 19-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0021701 published to Iwema et al. (hereinafter "Iwema") in view of U.S. Patent No. 5,523,775 issued to Capps (hereinafter "Capps"). Claims 11-16 and 32-42 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema in view of Capps and further in view of Microsoft Word. Claims 17-18 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema in view of Capps in view of Microsoft Word and further in view of U.S. Patent No. 6,683,600 issued to Lui (hereinafter "Lui"). Claims 1-44 are cancelled. Independent claim 45 is amended. Claims 46-47 are previously presented and claims 48-53 are new. Applicant asserts that amended independent claim 45 and the new independent claims include allowable features.

Independent claim 45 includes the following combination of features that is not taught or otherwise suggested by the cited references:

selecting an electronic pen for functioning as an electronic highlighter device;

engaging the electronic pen with a computer-displayed handwritten text selection;

in response to engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection;
and

setting the electronic ink height of the electronic pen to the determined height, **wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection.**

The above combination of features is not taught or otherwise suggested by the cited references. The Office Action contends that Iwema teaches "the method of determining the height of the computer-displayed handwritten text selection (see FIGs. 5, 10a and 10b) wherein determining the height of the computer-displayed handwritten text selection includes a least one member of a group (see FIG. 5) comprising; determining an average height of the computer-displayed handwritten text selection (see page 3 paragraph [0037] further see FIG. 5 describing vertical bounds at but not limited to page 5, paragraph [0055] further continued on page 60 without considering the length of any ascending or any descending character segment of characters comprising the computer-displayed handwritten text selection (see FIG. 5 further described at page 5, paragraph [0055]) and setting the electronic ink height of the electronic pen to the determined height." (Office Action at 15). In Fig. 5 of Iwema, Iwema teaches a handle that indicates the vertical bounds of the ink path. (Iwema at [0055]). With regard to Capps, Capps teaches detecting a highlighting input and highlighting a stroke over the text associated with the highlighting input. Neither reference teaches or otherwise suggests "in response to

engaging the electronic pen with the computer-displayed handwritten text selection, automatically determining the height of the computer-displayed handwritten text selection, wherein determining the height of the computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection" in combination with "setting the electronic ink height of the electronic pen to the determined height, wherein the set electronic ink height of the electronic pen is configured to highlight the average height of the computer-displayed handwritten text selection without highlighting any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection." Accordingly, applicant asserts that independent claim 45 is allowable over the cited references. With regard to the new claims, applicant believes that they include allowable features. With regard to the dependent claims, applicant believes that they also include allowable features. Furthermore, the dependent claims ultimately depend from the independent claims set forth above. As such they should be found allowable for at least the same reasons as their respective dependent claims.

IV. Request for Reconsideration

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

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Respectfully submitted,

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